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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,091	01/14/2002	Raymond P. Johnston	54404US008	6682
32692	7590	10/07/2003	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			LEWIS, KIM M	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/961,091

Applicant(s)

JOHNSTON ET AL.

Examiner

Kim M. Lewis

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: *Detailed Action*.

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 7/31/03 has been received and made of record in the application file wrapper. The specification has been amended as requested.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the reference made to "and combinations thereof" in claim 43 and "or any combination of any of the foregoing" in claim 57, lacks antecedent basis in the specification.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3761

Claims 36-50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 8, 9, 14-16, 19, 20, 25, 26, 35 and 36 of U.S. Patent No. 6, 420,622 B1 ("the '622 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims are merely broader.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36-39, 41-44, 46, 48, 51-55 and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,514,120 ("Johnston et al.").

Regarding claims 36-39 and 48, Johnston et al. disclose all features of the claimed invention. More specifically, Johnston et al. disclose a liquid management (control) film for absorbent articles comprising a liquid permeable topsheet (14), an optional liquid impermeable backsheet (16), an absorbent core which acts as a fluid reservoir (18) in a remote location, disposed therebetween, at least one liquid management member (20) comprising a film having at least one microstructure (v-shaped channel)-bearing hydrophilic surface that promotes directional spreading of liquids, an end portion, a fluid handling portion, and optionally an attachment member

such as a layer of adhesive or a component of a hook and loop fastening system on at least one side (column 2, lines 24-55).

Johnston et al. further disclose that the articles can take the form of meat tray liners, bed pads, baby diapers, sanitary napkins, and adult incontinent pads (column 1, lines 11-13). It is commonly known that sanitary napkins often take the place of wound dressings, specifically after a woman has given birth to a child.

Johnston et al. still further disclose that the channels comprise secondary channels, which form notches. The channels have a depth of between 5 and 3000 microns (column 4, line 16).

Regarding claim 41, Johnston et al. disclose an included angle of between 10 degrees and 120 degrees (col. 4, lines 2-4).

Regarding claim 42, Johnston et al. disclose the channels have a depth of about 5 microns to 3000 micron (col. 4, line 16).

Regarding claim 43, Johnston et al. disclose the material of the film being selected from the claimed group (col. 4, lines 41-48).

Regarding claim 44, Johnston et al. disclose thermoset material (col. 4, lines 60-63).

Regarding 46, Johnston et al. disclose that the absorbent articles may be made in the form of feminine hygiene products (*i.e.* tampons and sanitary napkins), one of said feminine hygiene products, namely tampons, may be placed inside of a user to absorb liquid. It is also well established that tampons have been used in the nasal area as a wound drain to absorb blood in the nose.

Art Unit: 3761

Regarding claims 51-55 and 58, the method of use of the claimed medical article is practiced by mere usage of the medical article of Johnston et al. as discussed above in the rejection of claims 36. As regards claims 55 and 58, the applicant should note that the exchange of fluids from one layer to the next layer and vice versa is inherent.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 47, 49, 50, 56, 57, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston et al.

Regarding claim 47, Johnston et al. fail to teach a medicament. However, it has been well established that the addition of medicaments (e.g., antimicrobials, antiseptics, analgesic, etc.) to absorbent articles such as wound dressings is *prima facie* obvious to one having ordinary skill in the art. When the medicament is combined with the absorbent article, the article will reduce the influx of contaminants into the medical site.

Regarding claims 49 and 50, Johnston et al. fail to teach that the film is translucent. However, the examiner contends that the materials from which the film is selected is made in transparent, translucent and opaque form, and that the selection of either type of material would have been an obvious design choice to one having ordinary skill in the art. The selection of either transparent or translucent allows for visualization of wound site. The applicant should note that it has been held that the recitation that an element is "adapted for" performing a function not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

Regarding claims 56 and 57, note the rejection of claim 47 above.

Regarding claims 59 and 60, note the rejection of claims 49 and 50 above.

### ***Response to Arguments***

Applicant's arguments filed 7/31/03 have been fully considered but they are not persuasive. As to applicant's arguments regarding the objection to the specification, the objection stands. There is a lack of antecedent basis in the specification for the claimed subject matter presented in claims 43 and 57 as stated above.

The applicant should note that claims are interpreted in light of the specification. As such, the examiner contends that the specification does not provide support for the phrases "and combinations thereof" and "or any combination of any of the foregoing" in claims 43 and 57, respectively. ***The applicant is advised to amend the specification to include the claimed subject matter.***

As regards applicant's arguments regarding the rejections under 35 USC 102 and 103, the applicant references comments during an interview held 6/4/01 for US Patent Application Serial No. 09/235,720 (the '720 application"); however, the subject matter discussed in the interview is not relevant since the claimed limitations of the present invention are different than the claimed limitations of the '720 application.

In the office action of the present invention, the examiner clearly points that "the remote area" is being defined as the absorbent core, which is remote from a medical treatment site (a patient).

### ***Conclusion***

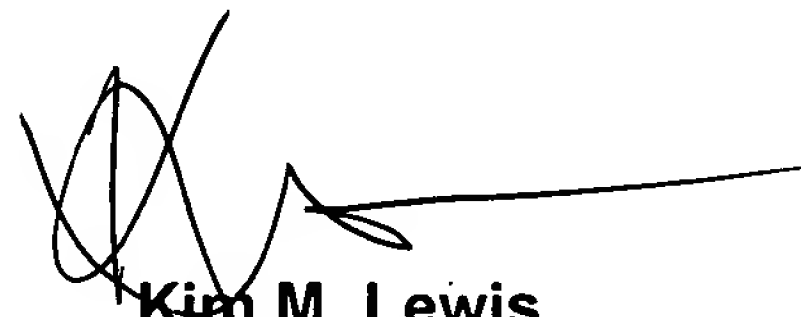
1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays and Tuesdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703.308.1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.3590 for regular communications and 703.305.3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0858.



**Kim M. Lewis**  
**Primary Examiner**  
**Art Unit 3761**

Application/Control Number: 09/961,091

Art Unit: 3761

Page 9

kml

October 6, 2003